

REMARKS

Claims 39 and 40 are pending. Claims 41 to 50 would also be pending in the application if the above amendments and new claims (proposed in applicants' Amendment filed on December 19, 2004) were entered. Applicants thank Examiners Shahnian-Shah and Swartz for their time to conduct a telephone interview on April 13, 2004. Claims 39 to 50 were discussed and potential amendments were proposed by both the applicants' representatives and the Examiners. The amendments proposed herein seek to revise the claims along the lines discussed during the interview.

Specifically, as suggested by the Examiners, applicants propose to amend claim 39 to recite a composition that includes a pharmaceutically acceptable excipient and a candidate antibacterial agent that specifically binds to an S-yneS polypeptide. Applicants also propose to amend claims 39 and 40 to recite that the antibacterial agents are anti-streptococcal agents.

Further, as discussed during the interview, applicants propose to amend dependent claims 41 and 42 to recite that the S-yneS polypeptide recited in claim 39 is a non-pathogenic and pathogenic *Streptococcus* polypeptide, respectively, and claims 46 and 47 to recite that the S-yneS polypeptide recited in claim 40 is a non-pathogenic and pathogenic *Streptococcus* polypeptide, respectively.

Although the proposed amendments and new claims would add several new terms, they would raise no new issues that would require further consideration and/or search. The amendments and new claims are supported throughout the application, e.g., at page 8, lines 1 to 11, page 38, lines 4 to 7, and by originally filed claims 3 to 7. Applicants submit that these amendments would place the claims into condition for allowance, or at least present the rejected claims in better form for consideration on appeal, and should therefore be entered after the final rejection under 37 C.F.R. § 1.116.

Entry of Amendments

The Examiner has declined to enter new claims 41 to 50 proposed by applicants in their Supplemental Reply to Final Office Action (filed December 19, 2004) because, according to the Advisory Action (at page 2, item 1):

New claims 41 to 50 require both new search and new rejection. New claims now recite that the polypeptide is derived from pathogenic and non-pathogenic strains of *Streptococci* and also the claims now recite a fusion protein comprising the polypeptide fused to a transcription activation domain of transcription factor or a DNA binding domain of transcription factor.

The above limitations have not been considered in the first and final rejections by the examiner in the history of prosecution.

Applicants respectfully maintain that these new claims would require no search. The new claims mirror claims 3 to 7 as allowed in U.S. Serial No. 09/163,445 (now U.S. Patent No. 6,472,377), which is the parent to the present application, and depend from independent claims 39 and 40. By definition, the new claims are more narrow than claims 39 and 40, and thus require no new search if claims 39 and 40 are found to be allowable.

However, during the interview, the Examiners expressed their view that the term "derived from" is particularly problematic with respect to new searches. Accordingly, as discussed during the interview and in the interest of moving the present application toward allowance, applicants propose to amend claims 41 and 42 to recite that the S-yneS polypeptide recited in claim 39 is a non-pathogenic and pathogenic *Streptococcus* polypeptide, respectively. Applicants also propose to amend claims 46 and 47 to recite that the S-yneS polypeptide recited in claim 40 is a non-pathogenic and pathogenic *Streptococcus* polypeptide, respectively. During the interview, the Examiners indicated that they would consider such amendments while reconsidering whether the new claims should be entered. Accordingly, applicants request entry and allowance of claims 41 to 50, as amended.

35 U.S.C § 112, Second Paragraph

Claims 39 and 40 remain rejected as allegedly indefinite because, according to the Advisory Action (at page 3, item 4):

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It is the examiner's position that the language as recited in part (b) of claims specially claim 39 is unclear. How can one assume that if a compound binds to a polypeptide can be a candidate antibacterial agent without further testing that compound?

Based on the above-quoted text from the Advisory Action and the April 13, 2004 interview, applicants understand that the present rejection concerns claim 39. Applicants respectfully maintain that the language of both claims 39 and 40 is clear. However, in the interest of moving the present application toward allowance and as suggested by the Examiners during the interview, applicants propose to amend claim 39 to recite a composition that includes a pharmaceutically acceptable excipient and a candidate antibacterial agent that specifically binds to an S-ynes polypeptide. Claims 39 and 40 would be amended to recite that the antibacterial agents are anti-streptococcal agents. Applicants respectfully submit that the Examiners' concerns about the clarity of the claims would be addressed if these amendments were entered. Accordingly, applicants request entry of these amendments and withdrawal of the present rejection.

CONCLUSION

Applicants ask that all amendments be entered and that all claims be allowed. Enclosed is a \$110 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 15132-090002.

Respectfully submitted,

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